

REMARKS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

Claims 1-18 are pending, but Claims 12-14 have been withdrawn in a previous response. Claims 1, 9 and 15-18 are amended. No new matter is introduced.

In the outstanding Office Action, Claims 15-16 were objected to; Claims 1, 9 and 15 were rejected under 35 U.S.C. § 101; Claims 1-11 and 15-18 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 9-11, 16 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Saneto (U.S. Patent Application Publication No. 2002/0085721).

Initially, Claims 15 and 16 are amended to address the informalities identified in the outstanding Office Action. Accordingly, it is respectfully requested that the objection to Claims 15 and 16 be withdrawn.

As to the rejection of Claims 1, 9 and 15 under 35 U.S.C. § 101, this rejection is respectfully traversed.

With regard to Claim 1, Applicants respectfully point out that Claim 1 is directed to a content reproduction apparatus and recites structural features such as a radio transmitter section and a radio receiver section. As an example, Figure 9 shows a content reproduction apparatus is a device which communicates with a content processing apparatus.¹ As such, the claimed content reproduction apparatus is very clearly a machine in accordance with 35 U.S.C. § 101, and is therefore statutory. Claim 9 is statutory under 35 U.S.C. §101 for similar reasons.²

¹ See the specification beginning at page 100.

² See Fig. 4 of the specification, for example.

To the extent that the Office is taking the position that inclusion of a software element in an otherwise statutory apparatus claim somehow takes the claims outside the realm of statutory subject matter, the Office is reminded that:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or machine**. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in the claim**. (Emphasis added).

Further, Claim 15 recites a content reproduction controlling method for controlling *a content reproduction apparatus* including a radio transmitter, radio receiver, and includes transmitting content via the radio transmitter and receiving content via the radio receiver.

The Supreme Court, however, has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) **it is tied to a particular machine or apparatus**, or (2) it transforms a particular article into a different state or thing. *See Benson*, 409 U.S. at 70 (“Transformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.”)³

It is submitted that Claim 15 is sufficiently tied to the content reproduction apparatus so as to render this claim patent-eligible under 35 U.S.C. § 101.

In view of the above discussion, it is submitted that Claims 1, 9 and 15, and any claim depending therefrom, is statutory under § 101, and therefore, it is respectfully requested that the rejection of Claims 1, 9 and 15 under 35 U.S.C. § 101 be withdrawn.

With respect to the rejection of Claims 1-11 and 15-18 under 35 U.S.C. § 112, second paragraph, Claims 1-11 and 15-18 have been amended to address the issues raised in the

³ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)(emphasis added.)

outstanding Office Action. To the extent that amendments to these claims do not address those issues the rejection is respectfully traversed.

MPEP § 2173.02 provides that:

Office policy is not to employ *per se* rules to make technical rejections. . . The test for definiteness under 35 U.S.C. 112, second paragraph, is **whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.”** *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). (Emphasis added.)

Based on the above language, Applicants submit that one of ordinary skill in the art would recognize what is claimed in the claims as amended herein based on at least Figures 13-17 and the associated discussion in the specification. Accordingly, it is respectfully submitted that Claims 1-11 and 15-18 comply with the requirements of 35 U.S.C. § 112, second paragraph, and it is respectfully requested that the rejection of Claims 1-11 and 15-18 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Turning to the rejection of Claims 9-11, 16 and 18 as being anticipated by Saneto, this rejection is respectfully traversed.

Claim 9 is directed to a content processing apparatus and recites:

a connection decision section configured to decide whether a connection is to be established to a content reproduction apparatus which stores a group ID produced uniquely according to a user account when said content processing apparatus is registered in the user account in a management server;

a first communication section configured to communicate with the content reproduction apparatus, when said connection decision section decides that a connection is to be established, the first communication section receiving *a content ID corresponding to content reproduced by the content reproduction apparatus* and the group ID stored in said content reproduction apparatus;

a second communication section configured to communicate with a content distribution server, the second

communication section *transmitting the content ID and the group ID to the content distribution server which provides a content download service*; and

a content storage section configured to store additional content corresponding to the content ID transmitted from said content distribution server and received through said second communication section, the contents stored in said content storage section being transmitted to said content reproduction apparatus through said first communication section. (Emphasis added.)

The applied reference, Saneto, describes a method for allowing use of content on any desired device by an authorized user while preventing use of the content by unauthorized third parties.⁴ More specifically, Saneto describes a personal computer (1-1) which executes a purchase application program (54-3) and a group gateway program (61) that encrypts the content using a group key sharable by all of the authorized user's devices.⁵ In operation, Saneto describes that the personal computer (1-1) and a personal computer (1-2) send credit card information to an approval server (3) to acquire a group key, ID and password from the approval server (3) with which to purchase content.⁶ Saneto also describes that content may be purchased and downloaded from an EMD server (4-3), together with content-associated data, such as music title, number of reproduction times, expiration of reproduction, and equalizer information.⁷

The outstanding Office Action appears to identify the ID provided by the approval server (3) described in Saneto as corresponding to the claimed content ID.⁸ However, Saneto does not describe that the ID corresponds to any content. Instead, Saneto describes the ID and password in correspondence with the credit card of the user. In other words, Saneto merely describes a user ID and password. In fact, Saneto only describes the content-

⁴ Saneto at paragraph [0009].

⁵ Saneto at paragraph [0069].

⁶ Saneto at paragraph [0070] and [0087].

⁷ Saneto at paragraph [0085].

⁸ See the outstanding Office Action at page 11.

associated data as corresponding to the content downloaded from the EMD server (4-3).⁹

However, Saneto only describes the content-associated data as being transmitted from the EMD server to the computer (1-1 or 1-2), but not from the computers (1-1, 1-2) to the EMD server.¹⁰ Conversely, amended Claim 9 recites a second communication section configured to communicate with a content distribution server and to *transmit* the content ID and the group ID *to the content distribution server*. Therefore, Saneto fails to disclose the claimed second communication section, and amended Claim 9 is believed to be in condition for allowance, together with any claim dependent therefrom.

Moreover, amended Claims 16 and 18 recite features substantially similar to those recited in amended Claim 9 and are believed to be in condition for allowance for substantially similar reasons. Accordingly, it is respectfully requested that the rejection of Claims 9-11, 16 and 18 under 35 U.S.C. § 102(b) be withdrawn.


⁹ Saneto at paragraph [0085].

¹⁰ Saneto at paragraphs [0084]-[0085].

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1-11 and 15-18 is earnestly solicited.

Respectfully submitted,

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